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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/783,876 | 02/20/2001 | Ival O. Salyer | 620526-004 | 2297 |

7590 10/29/2003
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EXAMINER

COONEY, JOHN M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,876

Applicant(s)

SALYER ET AL.

Examiner

John m Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 21-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-10, 13-15 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 12, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed 10-6-03 have been fully considered but they are not persuasive.

Rejections are set forth again below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11 and 12 rejected under 35 U.S.C. 102(b) as being anticipated by Lazar(5,185,111).

Lazar discloses products comprising filled, open-celled, microporous foams having cell sizes and degrees of filling at time of leaching and at time of being filled after being leached and dried which read on the products of applicants' claims (see column 2 lines 26-42, column 3 lines 17-25, column 5 lines 35-56, column 6 lines 3-8, the examples, as well as the entire document).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazar as applied to claims 1-3 and 11-12 above, and further in view of Meyer et al.(5,950,450).

Lazar differs from applicants' claims in that it does not seal its products in an evacuated, impermeable envelope. However, Meyer et al. discloses sealing materials in an evacuated, impermeable envelope for the purpose of enhancing barrier properties (see column 6 line 60 – column 10 line 45). Accordingly, it would have been obvious for one having ordinary skill in the art to have enclosed the articles of Lazar with an evacuated impermeable envelope for the purpose of preventing filler liquid loss in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' arguments have been considered. However, rejections are maintained for the reasons set forth above.

Applicants argue that the terminology "phase change material" excludes the sodium chloride and water mixtures of Lazar. However, applicants' supporting disclosure does not define this terminology in a manner supportive of this argument. The salt water solutions of Lazar, as well as, the "liquid fillers" of Lazar read on "phase change materials" when read from the standpoint of patentability.

Applicants argue that examiner's position that the reference anticipates the claims at the time of leaching and at time of being filled after being leached and dried is merely conjecture. However, examiner disagrees because the art though not concerned with giving full description of every step of their preparation demonstrates products containing the leachant within their products structures. Evidence is sufficient to support examiner's position that such is inherent to Lazar's disclosure, and, accordingly, burden is upon applicant to demonstrate factually how the products as claimed do, in fact, differ from the products of Lazar at the times stated. Additionally, however, these arguments do not address the fact that Lazar further teaches the filling of his articles with "liquid fillers" after being leached and dried which also reads on the products of applicants' claims.

Applicants' additionally argue that contents of phase change materials as claimed can not be achieved by the teachings of Lazar. However, it is the content of

leachant and void former, not just the void former, contained in the polymer during the leaching process that must be distinguished from the claims. The Office is not in a position to run experiments to verify such values, and, therefore, burden is maintained to be properly upon applicants to demonstrate in fact how their products as claimed do differ from the teachings of Lazar. Additionally, applicants' arguments do not address how their products differ on this point from the liquid filled products of Lazar.

Regarding applicants' arguments about pore sizes, examiner holds that the reference's teaching is sufficiently comprehensive in its particle size distribution (i.e. 0.5 –500 microns) that a position of anticipation of filled pore sizes encompassing of those claimed (i.e. 1-200 microns) is seen to be readily evident. Accordingly, it is maintained that examiner's envisioning of such to be inherent to Lazar's teaching is proper.

Applicants' arguments rest on the premise that all rejections fail based on the failings of Lazar. Therefore, no further remarks regarding the rejection under 35 USC 103 are held to be necessary.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

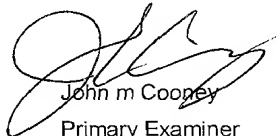
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John m Cooney whose telephone number is 703-308-2433. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, james seidleck, can be reached on (703) 308-2462. **Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.** The centralized facsimile number is **(703) 872-9306**. The changes are effective October 1, 2003.


John m Cooney
Primary Examiner
Art Unit 1711